

C. Remarks

The claims are 1-6 and 12-40, with claims 1, 6, 12, 24 and 28 being independent. Claims 7-11 have been cancelled without prejudice or disclaimer. Claim 4 has been amended for clarification and to correct its dependency. Claims 13, 25, 29 and 31 have been amended solely as to form. Claim 19 has been amended to correct a typographical error. No new matter has been added. Reconsideration of the claims is expressly requested.

Initially, as a formal matter, Applicants have noted that the Examiner did not acknowledge the claim to priority and did not confirm receipt of the certified copies of the priority documents. Since both the claim to priority and the certified copies were submitted during the international stage of the subject national stage application, acknowledgment of their receipt is respectfully requested.

Applicants also request that the Examiner initial the PTO-1449 as it relates to the "Biodegradable Plastics Handbook". While no English language translation of this document was submitted, the chemical structures therein required no translation, as noted by Applicants in the Information Disclosure Statement filed October 4, 2005.

Claims 1-40 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 6,645,743 B2 (the '743 patent). The grounds of rejection are respectfully traversed.

The '743 patent claims a PHA copolymer, which includes a 3-hydroxy- ω -(4-vinylphenyl)-alkanoate unit in its structure. Claim 2 in the '743 patent recites that the

PHA copolymer can also include a 3-hydroxy- ω -substituted alkanoate unit with a substituted phenyl group. However, while the present claims recite a para-substituted COOR₁ group on the phenyl ring, claim 2 in the '743 patent does not specify the location of its R₃ substituent. Furthermore, present claim 4 has been amended to specifically exclude a vinyl substituent on the phenyl ring in formula (5), which is required by the claims of the '743 patent. Thus, Applicants submit that the present claims are not obvious variants of the claims in the '743 patent.

Furthermore, claims 12-17 in the present application recite a resin composition, claims 18-23 recite a molding, claims 24-26 recite a charge controlling agent, claim 27 and 36 recites a toner, claims 28-35 recite a binder resin composition, claims 37-38 recite an image forming method and claims 39 and 40 recite an image forming apparatus. However, the claims in the '743 patent only recite a PHA copolymer and a process for its preparation. Thus, clearly, claims 12-40 cannot be a double patenting of the claims in the '743 patent.

Claims 1-40 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-40 of co-pending Application No. 10/532,136 (the '136 application).¹ Applicants respectfully disagree.

The Examiner has alleged that when R₂ in formula (3) in the '136 application is represented formula (8), where R₁ is by COOR' and R' is Na or K, the claims in the '136 application read on the present claims. However, claim 3 in the '136 application specifically excludes a structure in which the COOR' group in formula (8) is in

^{1/} The Examiner confirmed in a telephonic interview that Application No. 10/531,136 listed in the Office Action is incorrect.

the para position on the phenyl ring by its proviso. To the contrary, the present claims recite a para substituted COOR₁ group on the phenyl ring. Thus, clearly, the present claims are not in conflict with those in the '136 application.

Claims 1-13 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by the '743 patent. The grounds of rejection are respectfully traversed.

As discussed above with respect to the double patenting rejection, the '743 patent is related to the PHA copolymer and a process for its production. This PHA copolymer includes a 3-hydroxy- ω -(4-vinylphenyl)-alkanoate unit in its structure as a required component. While the '743 patent allows the structure to contain a 3-hydroxy- ω -substituted alkanoate with a substituted phenyl group, a specific para substitution on the phenyl ring is not disclosed in its claim 2. With respect to claims 12 and 13, the '743 patent does not disclose a resin composition including the presently claimed compound of formula (1) and a thermoplastic resin.

Accordingly, it is clear that the '743 patent does not anticipate the present invention. In addition, since the subject application and the '743 patent are both assigned to Canon Kabushiki Kaisha, the '743 patent cannot be used against the present claims in an obviousness rejection in accordance with the provisions of 35 U.S.C. § 103(c).

Wherefore, withdrawal of the outstanding rejections and expedient passage of the application to issue are respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our

below listed address.

Respectfully submitted,

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